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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,820	09/08/2003	Ashok V. Joshi	MIC-031103	1133
55162	7590	01/18/2007		
CERAMATEC, INC. 2425 SOUTH 900 WEST SALT LAKE CITY, UT 84119			EXAMINER EREZO, DARWIN P	
			ART UNIT 3731	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/18/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/657,820

Applicant(s)

JOSHI, ASHOK V.

Examiner

Darwin P. Erez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) 1-16, 24, 25, 30-33, 37, 38 and 42-51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-29, 55 and 60-63 is/are rejected.
- 7) ☒ Claim(s) 17-23, 26, 34-36, 39-41, 52-54, 56-59 and 64 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/30/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/30/06 has been entered.

Election/Restrictions

2. Independent claims 17 and 34 are deemed allowable over the prior art of record. The allowable subject matter is based on the limitation of "an osmotic cell, having an osmotic membrane, positioned between the cavity and the chamber, for removing the fluid from the sponge and transporting the fluid into the (retention) chamber". When interpreting this limitation, it has been determined that certain limitations from the specification is necessitated for the osmotic cell to be enabled and functional. That is, the limitation of an "osmotic cell having an osmotic membrane" is also being viewed as including a saturated salt solution/ or salt pellet in the chamber because having a higher solute concentration in the chamber is necessary to promote movement of the fluid in the cavity through the osmotic membrane and into the chamber. This embodiment is directed towards Species 7, as shown in Fig. 3A. See paragraph [0054] in the printed publication of this application.

The applicant also discloses Species 8, as shown in Fig. 3B, which is directed towards an electro-osmotic cell. However, the applicant does not recite any structure in the specification to enable one of ordinary skill in the art to make and/or use the invention. See paragraph [0056].

3. Since the allowable subject matter requires the specifics of Fig. 3A or 3B, the restriction requirement between Species 7 and 8, as set forth in the Office action mailed on 4/14/05 and 3/31/06, has been reconsidered and is hereby withdrawn. Therefore, claims 52-54, 56-59 and 64, directed towards Species 7, are no longer withdrawn from consideration because the claim(s) requires all the limitations of an allowable claim. However, claims 1-16, 24, 25, 30-33, 37, 38 and 42-51, directed towards nonelected species remain withdrawn from consideration because they do not all require all the limitations of an allowable claim.

In view of the above noted withdrawal of the restriction requirement, applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Claim Objections

4. Claims 17 and 34 are objected to because of the following informalities:

In claim 17, line 11, the applicant is suggested to switch "it" to either "the fluid" or "said fluid" in order to make the claim clearer.

In claim 34, line 8, the applicant is suggested to switch "it" to either "the fluid" or "said fluid" in order to make the claim clearer.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 27-29, 55 and 60-63 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims recite the limitation of "an electro-osmotic cell having a cationic membrane or an anionic membrane with an activation switch". However, the specification does not disclose any structure for the embodiment comprising said electro-osmotic cell to enable one skilled in the art to make or use the invention. See paragraph [0056]; the applicant does not provide any written description for the majority of the specific elements shown in Fig. 3B, such as reference number 126 and 128. The

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applicant merely recites that such cell is shown and described in a US patent but does not incorporate said reference into the specification

Mere reference to another application, patent, or publication is not an incorporation of anything therein into the application containing such reference for the purpose of the disclosure required by 35 U.S.C. 112, first paragraph. *In re de Seversky*, 474 F.2d 671, 177 USPQ 144 (CCPA 1973). 37 CFR 1.57(b)(1) limits a proper incorporation by reference (except as provided in 37 CFR 1.57(a)) to instances only where the perfecting words "incorporated by reference" or the root of the words "incorporate" (e.g., incorporating, incorporated) and "reference" (e.g., referencing) appear. The requirement for specific root words will bring greater clarity to the record and provide a bright line test as to where something is being referred to is an incorporation by reference.

The Office intends to treat references to documents that do not meet this "bright line" test as noncompliant incorporations by reference and may require correction pursuant to 37 CFR 1.57(g). If a reference to a document does not clearly indicate an intended incorporation by reference, examination will proceed as if no incorporation by reference statement has been made and the Office will not expend resources trying to determine if an incorporation by reference was intended.

Allowable Subject Matter

7. Claims 17-23, 26, 34-36, 39-41, 52-54, 56-59 and 64 would be allowable if rewritten to overcome the claim objections above.

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8. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record fails to teach and/or render obvious a wound therapy device comprising, inter alia, a fluid impermeable housing having a cavity and a chamber; a porous sponge associated with the cavity; and an osmotic cell having an osmotic membrane positioned between the cavity and the chamber, for removing the fluid from the sponge, and transporting said fluid into the chamber. As recited in the Election/Restriction section above, the limitation of the osmotic cell is being viewed as including a saturated salt solution/ or salt pellet in the chamber to promote osmosis.

The prior art of records, such as US 5,167,613 to Karami et al. and US 5,759,570 to Arnold, disclose wicking means instead of osmosis for transporting fluids.

Response to Arguments

9. Applicant's arguments with respect to claims 27-29, 55 and 60-63 have been considered but are moot in view of the new ground(s) of rejection.

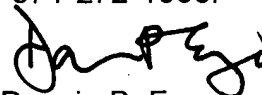
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darwin P. Erez who's telephone number is (571) 272-4695. The examiner can normally be reached on M-F (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Darwin P. Erez
Examiner
Art Unit 3731

de